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January 26, 2007

TTAB

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Opposition No. 91165809
Triforest Enterprises, Inc. v. Nalge Nunc International Corporation
Application Serial No. 76/572,253

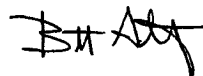
Dear Madam:

Enclosed find the following with respect to the above-referenced matter:

1. Applicant Nalge Nunc International Corporation's Trial Brief (Confidential/Unredacted Version) to be filed under seal;
2. Applicant Nalge Nunc International Corporation's Trial Brief (Public/Redacted Version);
3. Request for Oral Hearing; and
4. First-Class Mail Certification and postcard.

Please contact me if you have any questions regarding this matter.

Very truly yours,



Brett A Schatz

BAS:alf

Enclosures

cc: Theodore R. Remaklus, Esq. (w/o Enclosures)
Sarah Otte Graber, Esq. (w/o Enclosures)

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01-30-2007

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|---|---|-------------------------|
| <u>In re Application, Serial No. 76/572,253</u> |) | |
| TriForest Enterprises, Inc. |) | |
| |) | Opposition No. 91165809 |
| Opposer, |) | |
| v. |) | |
| |) | |
| Nalge Nunc International Corporation |) | |
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| Applicant-Respondent. |) | |
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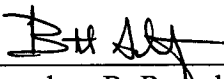
Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

REQUEST FOR ORAL HEARING

In accordance with Rule 2.129, Applicant requests an oral hearing in the above-noted opposition proceeding.

Respectfully submitted,

Dated: 1/26/07



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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid in an envelope addressed to: Commissioner for Trademarks, Trademark Trial and Appeal Board, P.O. Box, 1451, Alexandria, VA 22313-1451, on this 26th day of January, 2007.

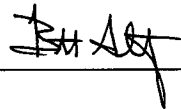
Date: 1/26/07

Anita L. Freeman
Anita L. Freeman

CERTIFICATE OF SERVICE

I hereby certify that the foregoing **REQUEST FOR ORAL HEARING** was served by First Class Mail, postage prepaid upon counsel for Opposer TriForest Enterprises, Inc., Clement Cheng, Esq., Law Offices of Clement Cheng, 17220 Newhope Street, Suite 127, Fountain Valley, California 92708, on this 26th day of January, 2007.

Dated: 1/26/07



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Nalge Nunc International Corporation |) | |
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| Applicant-Respondent. |) | |
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Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT'S TRIAL BRIEF
(PUBLIC/REDACTED VERSION)

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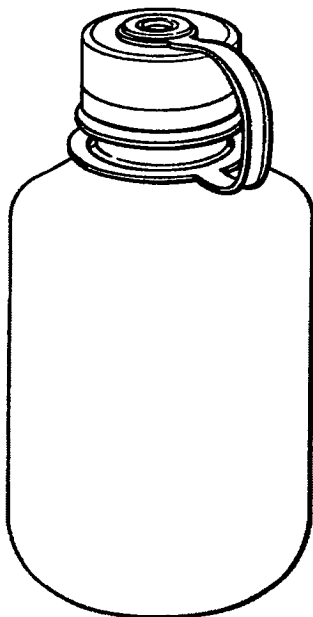
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DESCRIPTION OF THE RECORD

This brief is submitted in accordance with Rule 2.128(b) of the Trademark Rules of Practice, 37 CFR §2.128(b), and T.B.M.P. §801.03. The evidence of record consists of Applicant's pending federal application for the following mark, directed to the shape of the bottle shown on the drawing page of Application Serial No. 76/572,253 for *water bottles*, i.e., bottles that are used for *drinking*, classified by the USPTO in international class 21:

Serial No. 76/572,253
THE CONFIGURATION OF A
PLASTIC WATER BOTTLE, SOLD
EMPTY



The evidence of record also consists of the following:

- 1) Opposer's Response to Applicant's First Set of Requests for Admission, submitted under Applicant's Notice of Reliance filed September 26, 2006;
- 2) Opposer's Response to Applicant's First Set of Interrogatories, submitted under Applicant's Notice of Reliance filed September 26, 2006;
- 3) Third Party Design Patents and Trademark Registrations, submitted under Applicant's Notice of Reliance filed September 26, 2006.

Applicant has also made of record the following deposition transcripts:

- 1) the Trial Deposition of Margaret Gregory and exhibits thereto;
- 2) the Trial Deposition of Robert Cross and exhibits thereto;
- 3) the Trial Deposition of Frederic Edelstein and exhibits thereto;
- 4) the Trial Deposition of Paul Comeau and exhibits thereto;
- 5) the Trial Deposition of Samuel Belcher and exhibits thereto.

The only evidence made of record by Opposer is the Trial Deposition of Steven Lin and exhibits thereto. As noted immediately below, Applicant objected to much of Mr. Lin's testimony, and Opposer did not respond.

Also of record is the following:

- 1) Applicant's Objections to Trial Testimony of Steven Lin and Motion for Determination Adverse e to Opposer. Opposer did not respond to Applicant's Objections and Motion, and, therefore, Applicant's Objections and Motion is conceded. *See* T.B.M.P. § 707.03.

STATEMENT OF THE ISSUES¹

Whether Opposer has demonstrated through evidence that, under the *Morton-Norwich* factors, Applicant's mark is de jure functional, *i.e.*, whether Opposer has met its burden of proving that (1) there exists a utility patent directed to Applicant's unique water bottle mark, (2) Applicant touts utilitarian advantages of Applicant's mark in its advertisements, (3) there are no alternate and competitive designs to Applicant's mark, and (4) products bearing Applicant's mark are cheaper and simpler to manufacture than alternate and competitive designs.²

SUMMARY OF APPLICANT'S ARGUMENT

Opposer's Trial Brief, which is based on mere attorney argument and wholly lacking in evidentiary support, fails to mention, much less properly apply to Applicant's mark, each of the *Morton-Norwich* factors. Applicant has demonstrated through *evidence*, including deposition testimony of five witnesses with vast experience in the design, manufacture, and sale of water bottles, that every one of the *Morton-Norwich* factors weighs strongly in Applicant's favor. There is no evidence to the contrary.

First, Opposer does not even attempt to argue that Applicant has a utility patent covering its mark. Applicant demonstrates that there is no such utility patent, through the testimony of Margaret Gregory, who has over a decade of experience in marketing water bottles and developing brand recognition. Second, Opposer fails to address whether Applicant touts

¹ Opposer's Notice of Opposition is based in part upon an allegation that Applicant's mark lacks secondary meaning. Opposer failed to address secondary meaning in its Trial Brief and, therefore, appears to have withdrawn it as a basis for its Opposition. For sake of completeness, Applicant addresses the undeniable secondary meaning attributed to its mark herein.

² Opposer must make a prima facie case of functionality of Applicant's mark before the burden shifts to Applicant. *See 1 McCarthy on Trademarks*, § 7:72; citing *Valu Eng'g, Inc. v. Rexnord Corp.*, 61 U.S.P.Q. 2d 1422 (Fed. Cir. 2002).

utilitarian advantages of Applicant's mark in its advertisements, and there is no evidence upon which Opposer can rely to bear its burden on this point. Third, through countless exhibits and the testimony of Frederic Edelstein and Robert Cross, who collectively have over 25 years experience in sales of water bottles, Applicant demonstrates that there are numerous alternate and competitive designs to Applicant's mark. Even Steven Lin, *Opposer's President*, admits there are numerous alternate designs from which Applicant's competitors can select. These alternatives incorporate the elements of Applicant's mark, but do not fall within its scope, demonstrating that Applicant's mark does not monopolize any design features. Fourth, through the testimony of Paul Comeau and Samuel Belcher, who collectively have over 70 years experience in design and manufacture of plastics and plastic parts, Applicant demonstrates that products bearing Applicant's mark are no cheaper or simpler to manufacture. In fact, products bearing Applicant's mark are more expensive and complex to manufacture than alternate and competitive designs.

In sum, every one of the *Morton-Norwich* factors weighs strongly in Applicant's favor.

RECITATION OF FACTS

I. INTRODUCTION

A. THE PARTIES

Nalge Nunc International Corporation (“Nalge”)³ is a leading manufacturer and seller of plastic products for use in laboratory, packaging, environmental, biotech, and life science applications. Among its product offerings, Nalge sells water bottles for recreational drinking. Nalge’s water bottles are commonly referred to as either narrow or wide mouth bottles. The mark at issue in this opposition is Nalge’s narrow mouth water bottle mark shown on the drawing page of Application Serial No. 76/572,253.

Opposer is TriForest Enterprises, Inc. (“TriForest” and “Opposer”). TriForest describes itself as a producer of plastic products for the medical instrumentation market. TriForest sells plastic disposable and reusable products for use in laboratories, and for packaging, environmental, and various life science applications.

TriForest also sells water bottles. TriForest even concedes in its Trial Brief that it has sold competitive water bottles that do not fall within Nalge’s mark. In other words, TriForest concedes it has developed competitive products that are alternates to Nalge’s mark. (*See* Opposer’s Trial Brief, at p. 3).

The only testimony offered by TriForest is that of its President, Steven Lin. Mr. Lin admits he has only approximately five years experience in manufacturing, other than serving as an engineering student in his family’s business for a few school quarters. (Deposition of Steve Lin, “Lin Dep.,” at 45:22-47:3). Until 2001, Mr. Lin had no experience in the bottle industry,

³ Opposer incorrectly refers to Applicant as “Nalgene.” Nalgene is a registered trademark of Nalge, not its corporate name. Therefore, Applicant is appropriately referred to as “Nalge.”

manufacturing or otherwise. *Id.* at 44:3-23. Even now, Mr. Lin spends a majority of his time in marketing and design. *Id.*

B. PROCEDURAL BACKGROUND

Nalge filed its application at the U.S. Trademark Office for its narrow mouth water bottle mark (“the ‘253 Application’”) on January 26, 2004. Nalge first used the mark at least as early as April 19, 1992, first used the mark in commerce as early as April 19, 1992, and is now using the mark.

In the course of prosecuting the ‘253 Application, Applicant received one Office Action from the U.S. Trademark Office to address an outstanding formality with respect to the drawing page. Applicant complied with the formality in a written response that is of record in the file history for this application. Briefly, Applicant omitted fine lines in the cap of the water bottle mark that would not reproduce satisfactorily and other extraneous lines that were not features of the mark. The ‘253 Application was subsequently published in the Official Gazette for Trademarks on May 24, 2005, with the drawing page reproduced above.

Thereafter, the ‘253 Application was opposed by Opposer, TriForest.

C. FACTUAL BACKGROUND

Nalge has been selling its narrow mouth water bottle since approximately 1990. (Gregory Dep., at 6:10-7:4). Its sales of the narrow mouth water bottle have been continuous since that time, and it has always been a key part of Nalge’s product line. *Id.* With approximately 1000 employees and three facilities, Nalge’s dominance of the water bottle market is unrivaled. *Id.* at 8:20-9:4.

REDACTED

Nalge's narrow mouth water bottle is also the subject of frequent unsolicited publications and newspaper articles from across the country. *Id.* 35:19-42:11. Those articles include interviews of sales associates who indicate they "can't keep them [in the stores]" (*Id.* at 39:3-4) and that "kids go crazy over them" (*Id.* at 39:5-6). Another article indicates: "Nalge bottles: Retailers can't seem to keep these bottles on the shelves." *Id.* at 39:25-40:1. Demonstrating that the public mentally associates Nalge's water bottles with Nalge as the source is the following excerpt from the Anchorage, Alaska daily news:

And here's the best feature: It's cool. That's right, teenagers have given Nalgene bottles their hipness seal of approval. Galen Britton, 17, of Anchorage raves, 'Whenever they make a new one, you've got to get it.'

Id. at 41:18-42:11.

REDACTED

Consequently, Nalge is well known for selling water bottles (*Id.* at 7:23-8:19) and its customers mentally associate its mark for its narrow mouth bottle with Nalge as the source (*Id.* at 21:20-13:4). Clearly, the consuming public mentally associates the narrow mouth water bottle with Nalge:

Q: Would you consider yourself knowledgeable about the water bottle industry as far as selling water bottles?

A: I think so, yes.

Q: And is that based on your 20 years of experience?

A: Yes, and the fact that I use them in the field as well.

* * *

Q: Based on your experience in water bottles, would you say that Nalgene is recognized as a leader in the industry for selling water bottles?

A: Yes. Probably not a leader, the leader.

Q: So people that use water bottles know the Nalgene name?

A: Yes.

Q: And what to you base that on?...

A: Demand from our clientele for – for that bottle and we deal with three to four hundred active retail accounts and a few hundred more that are not so active, and visiting those accounts and seeing what they do in their store.

* * *

- Q: Based on your experience in the industry, would you say that the water bottle made to look like Exhibit 16 [Drawing page of Nalge's mark, which lacks any identification of the name Nalge] if it's a legitimate water bottle is a Nalgene narrow mouth water bottle?
- A: I would say so. I mean I would say that's what most people would assume if they saw a bottle like that.
- Q: Okay. So you would have a mental association between Exhibit 16 and Nalgene?
- A: Yes.
- Q: And would you say that your retail customers would make that same association?
- A: I think so.

(Cross Dep., at 4:9-7:2). Mr. Frederic Edelstein of CDI International, a designer and manufacturer of beverage-ware, is of the same opinion. (Edelstein Dep., at 7:11-8:1)(“Q: And based on your experience in the industry, do you mentally associate the figure in Exhibit 16 with Nalge as a company? A: Yes. Is it your opinion that your customers, that is CDI's direct customers, would also make that mental association? A: I think most would.”)⁴

Based on the foregoing, it is clear that there is secondary meaning associated with Nalge's narrow mouth water bottle. The consuming public recognizes Nalge's narrow mouth water bottle as being associated with Nalge as its source. This mental association stems from the design of the water bottle, not Nalge's name or other trademarks.

⁴ The testimony of Messrs. Cross and Edelstein confirm that consumers recognize the Nalge mark and mentally associate it with Nalge as the source. Opposer offers no evidence to the contrary. Rather, Opposer continuously relies upon unsupported assertions. For example, Opposer argues “[t]he Nalgene word mark is what makes the difference in the mind of the consumer, not shape.” (Opposer's Trial Brief, at p.4). Opposer makes this argument without a shred of evidence. Indeed, Opposer admits that it has no testing or surveys to support its assertion. (Lin Dep., at 82:3-12).

1. Nalge Has Never Applied For Or Received A Utility Patent Covering The Narrow Mouth Water Bottle

Nalge has never filed a utility patent application on its narrow mouth water bottle. *Id.* at 42:12-16. Accordingly, the first of the four *Morton-Norwich* factors falls in Nalge's favor, demonstrating that Nalge's narrow mouth water bottle mark is not functional.⁵

2. Nalge Does Not Tout Utilitarian Advantages In Its Advertising Or Otherwise

As with its other arguments, Opposer again fails to offer a shred of evidence that Nalge touts utilitarian advantages associated with its narrow mouth water bottle, in its advertising or otherwise. There is also a dearth of testimony on this issue. In fact, Opposer failed to even mention this factor in its Trial Brief. Accordingly, the second of the four *Morton-Norwich* factors falls in Nalge's favor.

3. All The Evidence Demonstrates That Alternate Designs Are Available To Competitors And Opposer Admits This Fact

All of the evidence submitted in this proceeding demonstrates that competitors have available to them numerous competitive alternatives to Nalge's mark. The evidence that best demonstrates this undeniable fact comes from the admission of Opposer's own President, Steven Lin:

Q: By Mr. Schatz: Would you agree with me that the bottle depicted in Exhibit 40 does not fall within the scope of the mark sought by Nalgene.

A: Yes.

* * *

⁵ Nalge addresses, and dispels with, Opposer's argument regarding random third party patents in Section III.A.1. The third party patents are not directed to Nalge's mark, but rather random third party designs unrelated to Nalge's mark, and are therefore irrelevant.

Q: And would Exhibit 40 function equally as well as the water bottle sought by Nalgene?

A: This is a squeezable bottle. It's not – it's a squeezable bottle. Other than that, it holds water. It's a water bottle.

Q: Okay. So the answer is "yes"?

A: Yes.

* * *

Q: Does the bottle depicted in Exhibit 42 fall within the scope of the mark sought by Nalgene?

A: Yes.

Q: It does?

A: No, it doesn't. Sorry. I didn't pay attention. It doesn't.

* * *

Q: So you would agree with me, then, that the bottle depicted as Exhibit 42 would function equally as well as a water bottle exhibiting the mark sought by Nalgene?

A: Yes.

* * *

Q: By Mr. Schatz: Would you agree with me that Exhibit 43 does not fall within the scope of the mark sought by Nalgene?

A: Yes.

Q: And does it function equally as well as a water bottle?

A: Yes.

Q: That demonstrates the mark sought by Nalgene?

A: Yes.

* * *

Q: By Mr. Schatz: In your opinion, does the bottle depicted in Exhibit 44 fall within the scope of the mark sought by Nalgene?

A: No, it's not a Boston Round.

Q: Does it function equally as well as a water bottle than the – a bottle demonstrating the mark sought by Nalgene?

A: Yes.

(Lin Dep., at 145:21–152:13).

Thus, Opposer, through its President, admits that at least Exhibits 40, 42, 43, and 44 are competitive alternatives. At the same time, these Exhibits are at least equally as functional as Nalge's mark. Further, they do not fall with the scope of Nalge's mark, but at the same time are plastic, transparent, generally cylindrical, and have rounded shoulders, a relatively narrow neck,

a generally flat bottom, an opaque screw cap with threads, a button connected to the cap, a strap or tether connected to the cap, and small and large annular rings. Consequently, by Opposer's own admission, there exist competitive alternatives to Nalge's mark, alternatives that include many, and in some cases all, of the elements depicted in Nalge's mark.

In fact, there are a vast number of competitive alternatives available, which likewise incorporate all of the elements of Nalge's mark. For example, the two water bottles depicted at the left of Exhibit 15 are plastic, transparent bottles with tethers and stems, but look different than Nalge's narrow mouth water bottle mark. (Edelstein Dep., at 8:5-11:3; Cross Dep., at 7:6-10:7). Even Opposer's President admits that these bottles look different than Nalge's mark. (Lin Dep., at 68:23-69:8). Yet they have the same elements as Nalge's mark, including a stem, tether, cap, and are plastic and transparent. *Id.* at 69:17-71:12. For example, the bottle depicted at the left of Exhibit 15 incorporates a tether that attaches to the top of the cap, differently than Nalge's mark. *Id.* at 66:3-7. In addition, the top annular ring is much larger than the ring depicted in Nalge's mark. *Id.* at 67:2-6.

Ironically, Opposer sells at least two water bottles that are competitive alternatives to Nalge's narrow mouth water bottle mark. Exhibit 19 is an alternative to Nalge's narrow mouth water bottle mark because it looks different and does not fall within the scope of the mark. (Edelstein Dep., at 12:11-15; Cross Dep., at 10:8-23). At the same time, Exhibit 19 has curvatures in the body of the bottle that allow users to grip the bottle easier than the Nalge's narrow mouth bottle. (Edelstein Dep., at 11:7-12:15; Cross Dep., at 10:8-23). Similarly, Exhibit 20 is an alternative water bottle offered by Opposer that looks different and does not fall within the scope of Nalge's narrow mouth mark, and incorporates indented panels sloping inward so that the bottle can better fit into a cup holder. (Edelstein Dep., at 12:16-13:14; Cross Dep., at

10:24-11:22). Mr. Lin concedes that Exhibit 20 has advantages as a water bottle because its design makes it easier to fit into a cup holder. (Lin Dep., at 92:5-25).

There are on the market today other examples of competitive alternatives incorporating the elements shown in the Nalge mark, such as a plastic and cylindrical body, flat bottom, screw cap, tether or other feature that retains the cap when opened, stem, but look different and do not fall within Nalge's mark. Many of the examples incorporate features that provide advantages over Nalge's narrow mouth bottle.

Examples include Exhibit 22, which incorporates indented panels for an easier fit into a cup holder (Edelstein Dep., at 13:15-14:9; Cross Dep., at 13:5-25), Exhibit 23, which incorporates a collapsible body for better storage (Edelstein Dep., at 14:13-15:7; Cross Dep., at 14:1-14), and Exhibit 24, which incorporates hand grips for better handling (Edelstein Dep., at 15:8-16:3). Other examples include Exhibit 29 (*Id.* at 16:8-24), Exhibit 30 (*Id.* at 16:25-17:13), Exhibit 32, which incorporates a hand grip for better handling (Edelstein Dep., at 17:17-18:18; Cross Dep., at 15:4-17:2), Exhibit 33, which incorporates grooves for gripping (Edelstein Dep., at 18:19-19:11; Cross Dep., at 17:3-13), Exhibit 36, which is collapsible for storage (Edelstein Dep., at 20:8-21:9; Cross Dep., at 19:5-11), Exhibit 37 (Edelstein Dep., at 21:10-22:20), Exhibit 38 (Edelstein Dep., at 22:21-23:13), Exhibit 39 (Edelstein Dep., at 23:14-24:3; Cross Dep., at 19:23-20:13), Exhibit 40 (Edelstein Dep., at 24:6-16), Exhibit 41 (Edelstein Dep., at 24:20-25:14; Cross Dep., at 20:16-21:7), Exhibit 42 (Edelstein Dep., at 25:15-26:10; Cross Dep., at 21:8-22:7), Exhibit 43 (Edelstein Dep., at 26:13-27:1), Exhibit 44, which is more user-friendly (*Id.* at 27:2-28:10), and Exhibit 45 (*Id.* at 28:11-29:1).

Other competitive alternatives include Exhibit 46, the cap of which rotates more efficiently than the cap of Nalge's narrow mouth water bottle and can be readily attached to a

carabiner, belt, or backpack. (Gregory Dep., at 46:3-47:9; Edelstein Dep., at 29:5-30:22; Cross Dep., at 22:8-24:1). The water bottles marked as Exhibits 48 and 49 also have caps that rotate more efficiently than the cap of Nalge's mark, because it incorporates a tether that does not hit a user's hand. (Gregory Dep., at 47:10-48:8; Edelstein Dep., at 31:22-32:14; Cross Dep., at 24:2-25:11). The caps of the water bottles marked as Exhibits 50 and 51 allow for access to the contents of the bottle quicker than Nalge's narrow mouth water bottle. (Gregory Dep., 48:9-21; Edelstein Dep., at 32:15-34:16; Cross Dep., 25:12-27:19).

Many competitive alternatives are, according to Opposer, better designs than Nalge's mark. For example, Steven Lin concedes that a square bottle design is better for storage. (Lin Dep., at 50:5-51:11; Exhibit 13). Mr. Lin also concedes that a bottle designed with convex walls maximize the autoclave, or disinfectant, process. *Id.* at 51:12-52:2.

There are also competitive alternatives that fall within the dimensional ratios set forth in the written description of Nalge's mark, *i.e.*, .4 and .8, but do not fall within the scope of Nalge's mark. For example, the ratio of the bottoms of Exhibits 46 and 48 relative to their overall height is .4, and the ratio of the height to their necks relative to their overall height is .8. (Comeau Dep., at 40:11-41:11).⁶ The ratio of the bottoms of Exhibits 49 and 50 relative to their overall height is .3, and the ratio of their height to their necks relative to their overall height is .7 and .79, respectively, within Nalge's mark. *Id.* at 41:12-42:7. The ratio of the bottom of Exhibit 51 relative to its overall height is .5, and the ratio of its height to its neck relative to its overall height is .8. *Id.* at 42:8-12. While falling within the dimensional ratios set forth in the written description of Nalge's mark, Exhibits 46, 48, 49, 50, and 51 look completely different than, and do not fall within the scope of, Nalge's mark.

⁶ Ratios have been rounded to the nearest tenth.

Accordingly, the third of the four *Morton-Norwich* factors falls in Nalge's favor.

4. The Narrow Mouth Water Bottle Mark Is Not A Comparatively Simple Or Cheap Method Of Manufacturing And Opposer Conceded This Fact By Not Responding To Nalge's Objections

Both procedurally and factually, the fourth and last of the *Morton-Norwich* factors falls in Nalge's favor. To explain, on October 20, 2006, Nalge filed its Objections to Trial Testimony of Steven Lin and Motion for Determination Adverse to Opposer. The basis for Nalge's Objections and Motion was Mr. Lin's refusal to answer questions regarding the method for manufacturing water bottles, despite its undeniable relevance to this opposition. Questions were posed to Mr. Lin to demonstrate that it is no cheaper or simpler to manufacture products according to Nalge's mark than manufacturing a functionally equivalent drinking bottle. Mr. Lin refused to answer questions regarding the relatively inexpensive costs of manufacturing Opposer's own drinking bottles.

In its Objections and Motion, Nalge requested a determination that the method for manufacturing products bearing Nalge's mark is no cheaper or simpler than manufacturing a functionally equivalent drinking bottle. In addition, Nalge requested a determination that the method for manufacturing Nalge's products bearing Nalge's mark is more expensive, complex, and difficult than manufacturing a functionally equivalent drinking bottle, including the two alternatives offered for sale by TriForest. Opposer did not respond to Nalge's Objections and Motion. Accordingly, Opposer has conceded these points. *See* T.B.M.P. § 707.03.

The evidence bears out these points, regardless. Generally speaking, a round plastic container such as Nalge's narrow mouth bottle is not necessarily the lowest cost container to

manufacture. (Belcher Dep., 34:9-35:16).⁷ Consequently, Nalge's narrow mouth water bottle may not be cheaper to manufacture, due to a variety of factors including the design of the mold, design of the parison, venting, resin, wall thickness, type of blow molding process employed, and whether automation or manual labor is employed. *Id.* at 34:9-45:11. Even assuming Nalge's narrow mouth water bottle was cheaper to manufacture, which it is not, it would not be due to the design of the bottle itself. Rather, any reduction in manufacturing costs would be attributed to Nalge's experience and expertise in manufacturing water bottles. *Id.* at 50:5-51:12.

In fact, there are several drawbacks and difficulties associated with manufacturing Nalge's narrow mouth bottle. Consequently, it is not cheaper or simpler to manufacture than competitive alternatives.

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⁷ Samuel Belcher has over 45 years of experience in the plastics industry. He has worked for Rubbermaid, Owens-Illinois, Wheaton Industries, and Cincinnati Milacron, all including aspects of plastics designs and manufacturing. He has numerous years of experience in injection blow molding, extrusion blow molding, design of blow molding machines, design and selection of molds, and design of plastic parts. Mr. Belcher has lectured and written numerous books and articles on these topics. *See generally*, Exhibit 57, Section G.

⁸ Paul Comeau has 26 years of experience in manufacturing plastic products and parts. *Id.* at 7:2-4.

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Consequently, there are several competitive water bottle designs in evidence that are at least as cheap, if not cheaper, and no more complex, to manufacture. For example, as compared to the Nalge narrow mouth design, the bottle depicted to the left of Exhibit 15 is quicker to manufacture, uses less material, produces no more scrap material, and is equally as easy to label and screen print. *Id.* at 17:6-19:17. That same bottle incorporates indentations for gripping, a feature that does not add any additional cost or time to the manufacturing process, nor does it reduce the strength of the bottle. *Id.* at 20:8-20.

Other alternative bottles, such as those depicted in Exhibits 15, 19, 24, 29, 30, 32, 34, 36, 37, 39, 40, 42, 45, and 48 are at least as cheap, and no more complex, to manufacture. For example, the bottle depicted in the middle of Exhibit 15 can be manufactured just as fast as the Nalge narrow mouth bottle, can be labeled and screen printed just as easy, and is equally strong.

Id. at 21:15-22:24. Exhibit 19 is quicker to manufacture, less costly, results in less scrap, but is just as strong as the Nalge narrow mouth bottle. *Id.* at 32:4-33:18. Exhibits 24, 29, and 30 result in no more scrap and take no longer to manufacture. *Id.* at 34:21-36:19.

Because their enclosures consist of only one component, the bottles marked as Exhibits 30, 32, 34, and 36 are not as expensive, but are quicker, to manufacture. *Id.* at 23:1-24:4. Manufacturing the bottles depicted in Exhibits 30, 32, 34, and 36 results in less scrap, but at the same time those bottles are just as easy to label and demonstrate similar strength characteristics as Nalge's narrow mouth bottle. (Comeau Dep., at 26:14; Belcher Dep., at 54:14-56:1). The bottle depicted as Exhibit 37 can be manufactured just as fast as the Nalge narrow mouth bottle, and is just as strong. (Comeau Dep., at 26:15-27:8). Similarly, the bottles depicted as Exhibits 39 and 40 can be manufactured just as fast, require no more material, result in no more scrap, and are just as strong. *Id.* at 27:9-29:20. The bottle depicted as Exhibit 42 can be manufactured faster than the Nalge narrow mouth bottle and costs less to manufacture. *Id.* at 29:21-31:2. At the same time, Exhibit 42 results in less scrap, but is just as easy to label, is just as strong, and is easier to manufacture. *Id.* at 31:3-32:3. Exhibit 45 can be manufactured quicker, with less cost and scrap, but is just as strong as the Nalge narrow mouth bottle. *Id.* at 32:4-33:18. Exhibits 48 and 49 would also be less expensive to make. (Belcher Dep., at 70:3-18).

In sum, the method of manufacturing Nalge's narrow mouth bottle is not cheaper or simpler to manufacture than competitive alternatives:

- Q: Based on the review of those bottles and based on your experience in manufacturing water bottles, would you say that there are competitive water bottles on the market to the Nalgene narrow mouth bottle that are competitive from a manufacturing standpoint-
- A: Yes.
- Q: -to the Nalgene narrow mouth bottle?
- A: Very much so.

Q: Would you say there are competitive water bottles on the market that are less costly to manufacture than the Nalgene narrow mouth bottle?

A: Yes.

(Comeau Dep., at 36:20-37:11).

Based on his 45 years of experience in manufacturing plastic parts and evaluation of the water bottles discussed above, Samuel Belcher reached the same conclusion:

Q: Solely by the design of [Nalge's narrow mouth water bottle], does that put the manufacturer at a competitive advantage over competitors from a cost of manufacturing standpoint?

A: I don't think so at all...

* * *

Q: Do you think you could design an enclosure assembly that costs less to manufacture than the closure described in [Nalge's narrow mouth water bottle]?

A: Yes.

Q: In your prospective design, could you design it so that the cap is retained by a tether?

A: Yes.

Q: And do so, but still make it cost less than [Nalge's narrow mouth water bottle]?

A: Yes. Yes...

(Belcher Dep., at 66:3-67:11).

Accordingly, the evidence demonstrates that numerous alternate designs are available to Nalge's competitors without sacrificing any advantages. Therefore, the fourth of the four *Morton-Norwich* factors falls in Nalge's favor, demonstrating that Nalge's narrow mouth water bottle mark is not functional.

II. LEGAL ARGUMENT

A. **Opposer Failed To Apply The *Morton-Norwich* Factors, Which Govern This Matter And Demonstrate That Nalge's Mark Is Not De Jure Functional**

To determine whether a mark is functional *legally*, the four *Morton-Norwich* factors must be applied. *Valu Eng'g, Inc. v. Rexnord Corp.*, 61 U.S.P.Q. 2d 1422, 1426 (Fed. Cir. 2002). In its Trial Brief, however, Opposer failed to set out, much less apply, any of the four *Morton-Norwich* factors. Rather, Opposer generically argued, for example, that Nalge's mark is directed to a bottle and therefore performs the function of holding fluid.⁹ However, Opposer's position has been directly refuted:

Our decisions distinguish de facto functional features, which may be entitled to trademark protection, from de jure functional features, which are not. 'In essence, de facto means that the design of a product has a function, i.e., a bottle of any design holds fluid.' [citation omitted]. De facto functionality does not necessarily defeat registrability.

Id.; see also *Textron, Inc. v. USITC*, 224 U.S.P.Q. 625, 628 (Fed. Cir. 1985) ("For this reason, this court and our predecessor court have made clear that only de jure functional designs, as contrasted with de facto functional designs, can be exempted from trademark protection.")

Opposer, mistakenly, spends the majority of its Trial Brief arguing that the elements of its *own* product serve a generic function. (See Opposer's Trial Brief, at pp. 9-21). Indeed, Opposer spends 7 pages of its Trial Brief describing "why Opposer adopted the old *TriForest* design" and generically explains how each serves a purpose. *Id.* at p. 9 ("The opposer designed the original bottle...The opposer then created the original bottle...The original bottle is made of plastic

⁹ Opposer spends much of its Trial Brief reviewing each element of Nalge's mark and arguing that each has a generic function. Simply, Opposer's argument misses the legal question at issue, which is whether alternate bottle designs exist that incorporate the elements in Nalge's mark, but do not fall within Nalge's mark. Because there are such alternate bottle designs, Nalge's mark is entitled to trademark registration.

because...The opposer made bottles that were transparent because . . .”) Opposer spends an additional 5 pages summarizing its own product in a chart.

For example, Opposer appears to argue that Nalge’s cap is functional because caps, generically, cover the container. Opposer’s position has been flatly rejected. *In re Morton-Norwich Prods, Inc.*, 213 U.S.P.Q. 9, 14 (CCPA 1982)(“What this phrase must mean is not that the generic parts of the article or package are essential, but, as noted above, that the particular design of the whole assembly of those parts must be essential.”); *In re R.M. Smith, Inc.*, 222 U.S.P.Q. 1, 2 (Fed. Cir. 1984)(“In essence, de facto functional means that the design of a product has a function, i.e., a bottle of any design holds fluid. De jure functionality, on the other hand, means that the product is in its particular shape because it works better in this shape.”). Opposer’s argument has been specifically rejected in cases involving product packaging. *AmBrit, Inc. v. Kraft, Inc.*, 1 U.S.P.Q. 2d 1161 (11th Cir. 1986)(“That individual elements of *packaging* are functional does not, however, render the package as a whole unprotectable.”)(emphasis added).

1. Nalge Has Never Applied For Or Received A Utility Patent Covering The Narrow Mouth Water Bottle

The first of the four *Morton-Norwich* factors considers whether Nalge has ever filed a utility patent application on its narrow mouth water bottle. Nalge has never done so. (Gregory Dep., at 42:12-16). Accordingly, the first of the four *Morton-Norwich* factors falls in Nalge’s favor.

Opposer cobbles together various elements from utility patents in a failed attempt to argue that Nalge’s mark is functional. Opposer has essentially created a jigsaw puzzle of patent claims by searching the millions of issued patents to find random statements and portions of statements to support its position in its Trial Brief. In doing so, Opposer violated black letter

trademark law that “merely labeling each design feature as ‘useful’ or as ‘serving a utilitarian purpose’ cannot, as a matter of law, render the entire configuration de jure functional.” *In re Teledyne Indus., Inc.*, 217 U.S.P.Q. 9, 11 (Fed. Cir. 1982). Considering the volume of patents available, one could easily find such evidence to support functionality of *any* element of *any* configuration, product or otherwise, including the Chanel or Listerine bottles that Opposer concedes are ornamental and registrable. (*See* Opposer's Trial Brief, pp. 8-9).

The correct issue is whether Nalge's mark as a whole is functional. *Morton-Norwich*, 213 U.S.P.Q. at 14 (the phrase “nonfunctional” means “that the particular design of the *whole* assembly of those parts must be essential.”)(emphasis added). Opposer has failed to present any evidence on whether Nalge's mark as a whole is functional.

Opposer's patent references are irrelevant for the additional reason that they are not directed to Nalge's mark, but random third party designs. *See Cable Electric Prods, Inc. v. Genmark, Inc.*, 226 U.S.P.Q. 881, 891 (Fed. Cir. 1985)(reversing the trial court's holding of functionality). None of the third party designs depicted in the utility patents cited by Opposer remotely resemble Nalge's mark. For example, Opposer refers to the Berney patent, which is directed to a gasoline can, the Birnbaum patent, which is directed to a bottle stopper, and the Schiemann patent, which is directed to a screw stopper that generates an acoustic signal when closed. Because these patents do not cover or remotely resemble Nalge's mark, the Federal Circuit admonishes that they should be disregarded:

In resolving the question of product design functionality for purposes of the Lanham Act, Section 43(a), the fact finder is to consider the appearance of the *products* in issue. Reference to utility patent claims that are, or have been, asserted to read on either product, or to the appearance of the device depicted in figures included in the patent specification supporting such claims, must be done with caution. [citations omitted]. Claims may be capable of reading on many devices of strikingly different

configuration...A manufacturer may choose in its commercial embodiment of a patented device to less than faithfully replicate the exemplary depiction of a claimed embodiment shown in the figures of the patent.

Id.

Accordingly, there is no utility patent directed to Nalge's mark, and the first of the four *Morton-Norwich* factors weighs in Nalge's favor.

2. Nalge Does Not Tout Utilitarian Advantages In Its Advertising Or Otherwise

There is no evidence suggesting Nalge touts utilitarian advantages that may be associated with its narrow mouth water bottle. There is also a dearth of testimony on this issue. In fact, Opposer failed to discuss this factor in its Trial Brief. Accordingly, the second of the four *Morton-Norwich* factors falls in Nalge's favor.

3. All The Evidence Demonstrates That Alternate Designs Are Available To Competitors And Opposer Admits This Fact

The *Morton-Norwich* court noted that "the effect on competition is really the crux of the matter" *Id.* at 16. Consequently, it is "significant that there are other alternatives available" and if such alternatives are available, the mark is not functional. *Id.* On this point, the *Morton-Norwich* court referred to a strikingly similar case involving bottles for holding liquid, finding that "[o]thers can meet any real or imagined demand for wine in decanter-type bottles...without being in the least hampered in competition by inability to copy the Mogen David bottle design." *Id.* The same is true here, where numerous alternative designs to hold liquid exist.

The following comments from the *Morton-Norwich* case, which immediately precede the court's decision that the mark at issue in that case was not functional, are particularly relevant, and decisive here:

In the first place, a molded plastic bottle can have an infinite variety of forms or designs and still function to hold liquid. No one form is necessary or appears to be 'superior.' Many bottles have necks, to be grasped for pouring or holding, and the necks likewise can be in a variety of forms. The PTO has not produced one iota of evidence to show that the shape of appellant's bottle was required to be as it is for any de facto functional reason, which might lead to an affirmative determination of de jure functionality. The evidence, consisting of competitor's molded plastic bottles for similar products, demonstrates that the same functions can be performed by a variety of other shapes with no sacrifice of any functional advantage. There is no necessity to copy appellant's trade dress to enjoy any of the functions of a spray top container.

Id. at 16.

As applied here, there are numerous alternative designs available to competitors without having to sacrifice any advantages. In fact, as noted above, Opposer's President admitted that there are at least four alternate designs available. (Lin Dep., at 145:21–152:13, referring to Exhibits 40, 42, 43, and 44). These designs incorporate, generically, the elements depicted in Nalge's mark, but do not fall within Nalge's mark. Consequently, and contrary to Opposer's argument, it is evident that Nalge's mark does not monopolize designs of water bottles, or even designs of particular elements of water bottles.

The evidence offered by Nalge demonstrates that there are numerous other competitive alternatives are available. For example, the two water bottles depicted at the left of Exhibit 15 have tethers and stems, but look different than Nalge's narrow mouth water bottle mark. (Edelstein Dep., at 8:5-11:3; Cross Dep., at 7:6-10:7). Opposer sells Exhibits 19 and 20, which are two competitive alternatives to Nalge's narrow mouth water bottle mark. (Edelstein Dep., at 11:7-13:14; Cross Dep., at 10:8-11:22).

Other examples of competitive alternatives incorporating elements of Nalge mark, such as a plastic and cylindrical body, flat bottom, screw cap, tether or other feature that retains the cap when opened, and stem, and which function at least equally as well but look different and do

not fall within Nalge's mark, include Exhibit 22, which incorporates indented panels for easier fit into a cup holder (Edelstein Dep., at 13:15-14:9; Cross Dep., at 13:5-25), Exhibit 23, which incorporates a collapsible bottle for better storage (Edelstein Dep., at 14:13-15:7; Cross Dep., at 14:1-14), Exhibit 24, which incorporates hand grips for better handling (Edelstein Dep., at 15:8-16:3), Exhibit 29 (*Id.* at 16:8-24), Exhibit 30 (*Id.* at 16:25-17:13), Exhibit 32, which incorporates a hand grip for better handling (Edelstein Dep., at 17:17-18:18; Cross Dep., at 15:4-17:2), Exhibit 33, which incorporates grooves for gripping (Edelstein Dep., at 18:19-19:11; Cross Dep., at 17:3-13), Exhibit 36, which is collapsible for storage (Edelstein Dep., at 20:8-21:9; Cross Dep., at 19:5-11), Exhibit 37 (Edelstein Dep., at 21:10-22:20), Exhibit 38 (Edelstein Dep., at 22:21-23:13), Exhibit 39 (Edelstein Dep., at 23:14-24:3; Cross Dep., at 19:23-20:13), Exhibit 40 (Edelstein Dep., at 24:6-16), Exhibit 41 (Edelstein Dep., at 24:20-25:14; Cross Dep., at 20:16-21:7), Exhibit 42 (Edelstein Dep., at 25:15-26:10; Cross Dep., at 21:8-22:7), Exhibit 43 (Edelstein Dep., at 26:13-27:1), Exhibit 44, which is more user-friendly (*Id.* at 27:2-28:10), and Exhibit 45 (*Id.* at 28:11-29:1).

Other competitive alternatives include Exhibit 46, the cap of which rotates more efficiently than the cap of Nalge's narrow mouth water bottle and can be readily attached to a carabiner, belt, or backpack. (Gregory Dep., at 46:3-47:9; Edelstein Dep., at 29:5-30:22; Cross Dep., at 22:8-24:1). The water bottles marked as Exhibits 48 and 49 also have caps that rotate more efficiently than the cap of Nalge's narrow mouth water bottle, without causing the tether to hit one's hand. (Gregory Dep., at 47:10-48:8; Edelstein Dep., at 31:22-32:14; Cross Dep., at 24:2-25:11). The caps of the water bottles marked as Exhibits 50 and 51 allow for access to the contents of the bottle quicker than Nalge's narrow mouth water bottle. (Gregory Dep., 48:9-21; Edelstein Dep., at 32:15-34:16; Cross Dep., 25:12-27:19).

Applying the *Morton-Norwich* court's holding here, "the crux of the matter..." is that there are numerous competitive alternatives to Nalge's mark. The evidence demonstrates that other manufacturers can, and do, successfully compete in the water bottle market, and offer water bottles with the same elements as those depicted in Nalge's mark, without falling within Nalge's mark. This demonstrates that Nalge's mark is not functional.

**4. The Narrow Mouth Water Bottle Mark Is Not A
Comparatively Simple Or Cheap Method Of Manufacturing
And Opposer Conceded This Fact By Not Responding To
Nalge's Objections**

As noted above, Mr. Lin refused to answer questions regarding the relatively inexpensive costs of manufacturing Opposer's own drinking bottles. Opposer did not respond to Nalge's Objections to Trial Testimony of Steven Lin and Motion for Determination Adverse to Opposer, in which Nalge requested a determination that the method for manufacturing Nalge's products bearing Nalge's mark is no cheaper or simpler than manufacturing a functionally equivalent drinking bottle. In addition, Nalge requested a determination that the method for manufacturing Nalge's products bearing Nalge's mark is more expensive, complex, and difficult than manufacturing a functionally equivalent drinking bottle, including those offered by Opposer. By not responding, Opposer has conceded these points. *See* T.B.M.P. § 707.03.

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There are several competitive water bottle designs in evidence that are at least as cheap, if not cheaper, and no more complex, to manufacture. For example, as compared to the Nalge narrow mouth design, the bottle depicted to the left of Exhibit 15 is quicker to manufacture, uses less material, results in no more scrap material, and is equally as easy to label. *Id.* at 17:6-19:17. That same bottle incorporates indentations for gripping, a feature that does not add any additional cost or time to the manufacturing process, nor does it reduce the strength of the bottle. *Id.* at 20:8-20. Other alternative bottles, such as those depicted as Exhibits 15, 19, 24, 29, 30, 32, 34, 36, 37, 39, 40, 42, 45, and 48 are at least as cheap, and no more complex, to manufacture. In sum, the method of manufacturing Nalge's narrow mouth bottle is not cheaper or simpler to manufacture than competitive alternatives. (Comeau Dep., at 36:20-37:11; Belcher Dep., at 66:3-67:11).

Accordingly, the evidence demonstrates that holding a liquid can be performed by a variety of other shapes without sacrificing any advantages. If Opposer's manufacturing costs are truly higher as claimed (without any evidentiary support), then it is due to poor engineering techniques and lack of experience in manufacturing water bottles, as opposed to the design of the water bottle itself. (Belcher Dep., at 34:9-51:12).

Further, alternative designs exist, at an equivalent manufacturing cost, and in many cases at less cost. These alternative designs are viable products that currently compete with Nalge's narrow mouth water bottle. At the same time, the mere existence of these alternative designs demonstrates that it is not competitively necessary to copy Nalge's mark. Therefore, the fourth of the four *Morton-Norwich* factors falls in Nalge's favor.

B. Opposer's Unsupported Assertions Should Be Disregarded

The bulk of Opposer's Trial Brief is based upon factually unsupported assertions, which should be disregarded. (*See* T.B.M.P. § 707.03: "Statements made in pleadings cannot be considered as evidence on behalf of the party making them; such statements must be established by competent evidence during the time for taking testimony.") The only evidence Opposer relies upon is the testimony of Steven Lin, who has only five years experience in manufacturing. (Lin Dep., at 45:22-47:3). When compared with 70 years of combined experience of Messrs. Belcher and Comeau, Opposer's "evidence" is wholly unreliable.

For example, Opposer argues that the "Boston Round" bottle design is old, rendering Nalge's mark commonplace and not the proper subject of a trademark. (*See* Opposer's Trial Brief, at p. 3). Opposer's argument fails for several reasons, but primarily due to the fact that it is based on attorney argument, rather than evidence. Opposer also relies on prints of websites of Owens-Illinois and Bomatic to support its argument. However, the websites are from 2006, predated by Nalge's narrow mouth bottle, which was sold at least by April 1992, 14 years prior.

Opposer's argument also disregards the fact that Samuel Belcher, during his 45 years of experience in the plastics industry, was once employed at Owens-Illinois and has personal knowledge regarding the "Boston Round." Owens-Illinois first used that term, generically, for

any round bottle with a sloping shoulder. (Belcher Dep., at 56:2-57:8).¹⁰ Therefore, “Boston Round” is not one particular bottle design. *Id.* at 58:11-14. It follows that Nalge could not have simply taken the Boston Round bottle and put a cap and tether on it, as alleged by Opposer. Regardless, Opposer glosses over the fact that the “Boston Round” does not incorporate the unique features described in Nalge’s mark, including an opaque screw cap with threads, a button connected to the cap, a strap or tether connected to the cap, or small and large annular rings.¹¹

In its Trial Brief, Opposer alleges that “[m]aking the bottle round would increase the volume and contribute to a de jure utilitarian advantage...” (See Opposer’s Trial Brief, at p. 9). Opposer’s allegation is wholly unsupported, constitutes nothing more than attorney argument, and should be disregarded.

Also a page 9, Opposer alleges that “[t]he particular functional advantages if monopolized by [Nalge], would limit TriForest’s revenue by limiting product design choices.” Once again, there is no evidence to support Opposer’s allegation. To the contrary, through testimony and exhibits of products that compete with Nalge’s narrow mouth water bottle, the only conclusion that can be drawn is that Opposer has available to it numerous alternate bottle designs. Accordingly, Opposer’s allegation should be disregarded.

At pages 9-16, Opposer illogically relies upon its own Interrogatory responses to support its arguments. Because they are wholly unsupported, the following arguments should be disregarded: (a) “During the autoclave process, the plastic is particularly well-suited for the

¹⁰ Steven Lin concedes that Owens-Illinois made the first Boston Round. (See Exhibit 18, Opposer’s Interrogatory Responses, at p. 12).

¹¹ The unique features of Nalge’s mark distinguish it from Opposer’s reference on page 27 of its Trial Brief to *1 McCarthy on Trademarks*, at §7:87. That reference analyzed two cases involving strait cylinder tubes lacking any unique features. See *In re Int’l Playtex Corp.*, 155 U.S.P.Q. 745 (TTAB 1967)(unadorned cylinder for packaging girdles) and *Keebler Co. v. Rovira Biscuit Corp.*, 207 U.S.P.Q. 465 (1st Cir. 1980)(unadorned cylinder for packaging crackers).

construction of the bottle” (page 11); (b) “The bottle is generally cylindrical with rounded shoulders because some machines roll the bottle” (page 12); (c) “Also, the bottle been [sic] generally cylindrical with rounded shoulders allows a greater volume to surface ratio... This is helpful when optimizing construction so that the plastic use is minimized and the strength of the bottle is maximized” (page 12); (d) “The narrow mouth bottle is good because it is easier to pour of [sic] the contents or to drink from the bottle... Milk is put into bottles that have a narrow mouth because this makes it easier to pour the milk” (page 12); (e) “The screw cap is opaque and engaged with threads on the upper portion of the neck because transparent material is more expensive and difficult to work with on a screw cap” (page 13)¹²; (f) “The snap on version is too easily snapped off” (page 13); (g) “The connection is formed as a button because the button configuration provides a good axial connection while maintaining low weight and cost” (page 14); (h) “Other alternatives such as Sonic welding would require additional machinery and production process” (page 14); (i) “If the top ring were larger than the bottom, the ring would protrude over the top surface of the cap and hinder the fingers of the user” (page 14-15); (j) “The top ring being in [sic] the same size as the top surface of the cap would limit the user to grasping only the side surfaces of the cap (page 15); (k) “The ratio of the diameter of the generally cylindrical body to the overall height of the water bottle is approximately .4 because in a 500ml cylindrical container, that ratio produces a circumference that is approximately equivalent to the size of an average person’s hand” (page 15)¹³; (l) “The .4 ratio is particularly comfortable and

¹² Mr. Belcher testified that Mr. Lin’s statement is incorrect. Because it requires colorant, opaque material is more expensive than transparent material. Consequently, it is more expensive to manufacture an opaque screw cap. (Belcher Dep., 59:17-62:14).

¹³ Opposer’s argument regarding what constitutes “an average person’s hand” is patently absurd, and is unsupported by any evidence whatsoever. Opposer admitted that it did not perform any consumer surveys to determine what bottle designs are easiest to grip. (Lin Dep., at 59:11-60-1). In fact, Mr. Lin testified that he does not know the size of an average person’s hand. *Id.* at

easy to hold” (page 15); (m) “The ratio of the height of the generally cylindrical body extending between the neck and the container bottom to the overall height of the water bottle is approximately 0.8 because with the .4 ratio previously mentioned, the cap would be on the order of several inches in height” (pages 15-16). None of these allegations are supported by any testimony or other evidence and should be disregarded.

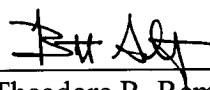
III. CONCLUSION

All of the *Morton-Norwich* factors fall in Nalge’s favor, and demonstrate that Nalge’s mark is not functional. Through its extensive marketing and sales, and direct testimony, Applicant has also demonstrated that consumers mentally associate Nalge’s mark with Nalge as its source. As such, Nalge’s mark has acquired secondary meaning.

Accordingly, Applicant respectfully requests that the opposition be denied with prejudice and that the subject application pass on to registration.

Respectfully submitted,

Dated: 1/26/07



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100:15-18 (“Q: What’s the size of an average person’s hand? A: That’s a big question. Q: So you don’t know? A: I don’t know.”)

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid in an envelope addressed to: Commissioner for Trademarks, Trademark Trial and Appeal Board, P.O. Box, 1451, Alexandria, VA 22313-1451, on this 26th day of January, 2007.

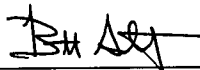
Date: 1/26/07

Anita L. Freeman
Anita L. Freeman

CERTIFICATE OF SERVICE

I hereby certify that the foregoing **APPLICANT'S TRIAL BRIEF** was served by First Class Mail, postage prepaid, upon counsel for Opposer TriForest Enterprises, Inc., Clement Cheng, Esq., Law Offices of Clement Cheng, 17220 Newhope Street, Suite 127, Fountain Valley, California 92708, on this 26th day of January, 2007.

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